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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,625	08/01/2000	Andreas Helfenstein	67736	6857

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MCGLEW & TUTTLE, PC
1 SCARBOROUGH STATION PLAZA
SCARBOROUGH, NY 10510-0827

EXAMINER

NGUYEN, ANTHONY H

ART UNIT PAPER NUMBER

2854

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/630,625	Applicant(s) HELFENSTEIN ET AL.	
	Examiner Anthony H Nguyen	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,3-6 and 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 27, 2004 has been entered.

Specification

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

Claims 1, 3-6 and 8-13 are objected to because the claim language is vague and lack of proper antecedent basis. For examples, the language "to determine . . . to be bound." (claim 1 lines 14-17), "in the strand to be bound is recorded in the strand to be bound by said sensor for the strand to be bound on a said single web strand of the strand to be bound" (claim 6 lines 13 and 14) is vague since it is awkward and unclear to what the strand to be bound is taken for determining it's cutting position. Additionally, there is no proper antecedent basis for "the strand to be bound" (claim 1, lines 5,6 and 10) and "the web strand" (claim 1, line 12), "said strand to

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be bound" (claim 3 line 1), "the recorded measured value" (claim 3 line 3). Further, one of the word "the" or "said" (claim 6 line 11) and "a" or "said" (claim 6 line 14) should be deleted.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-6, 10- 12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Niedermaier et al. (US 5,123,316).

With respect to claims 1,3,4, 6 and 10-14, Niedermaier et al. teaches a process and a device for determining cutting positions of web strands which including a step of recording each individual web strand 9.1-9.8 by the web strand sensors 64.1-64.8 and recording a common measured value for cutting the position of the strips or the web strands 16 and 17 by the reading heads or sensors 59, 60 which sense the cutting register marks and compare to a nominal value or a common value via a control device 62 before the web strands are brought together to a cutting device 19 (Fig.1). See Niedermaier et al., claim 1, col.4 lines 35-48. and col.6 lines 5-14. With respect to claim 4, Niedermaier et al. teaches the use of synchronous control 63 and 66 (Niedermaier et al., Fig.1) that are electronically connected to the strip-cutting device 19 and a register control device 65 for control the cutting position of the web strands. With respect to claims 5 and 13, the values for cutting positions which are set manually at the time of start-up the press and the use of a common control device and individual control devices which send adjust signals to the common control device while not specifically stated in Niedermaier et al. are necessary to provide an operative press.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 9 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Niedermaier et al. (US 5,123,316) in view of Bergland et al. (US 5,016,182).

Niedermaier et al. teaches all that is claimed, except for the optical scanner, which detects optical print marks, is not clearly shown. Bergland et al. teaches a register control means having an optical scanner 38 which detects optical marks printed on the web (W) (Bergland et al., Fig. 1, and the paragraph bridging columns 5 and 6). In view of the teaching of Bergland et al., it would have been obvious to one of ordinary skill in the art to modify the device of Niedermaier et al. by substituting the optical scanner as taught by Bergland et al. to permit more precise control the cutting position on a web or a web strand.

Response to Arguments

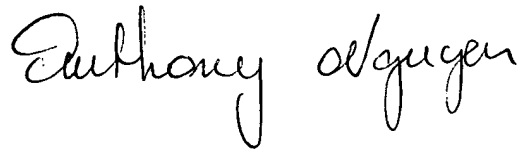
Applicants' arguments with respect to claims 1,3-6 and 8-14 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (571) 272-2169. The examiner can normally be reached daily from 9 AM to 5PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (571) 272-2168. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink that reads "Anthony Nguyen". The signature is written in a cursive, flowing style.

Anthony Nguyen
8/26/04
Patent Examiner
Technology Center 2800